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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,613

05/29/2007

Marc Peuker

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05/23/2012

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EXAMINER

PAGAN, JENINE MARIE

ART UNIT

PAPER NUMBER

3728

NOTIFICATION DATE

DELIVERY MODE

05/23/2012

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com

Office Action Summary	Application No. 10/598,613	Applicant(s) PEUKER ET AL.	
	Examiner JENINE PAGAN	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-25 is/are pending in the application.
- 5a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-10 and 20-25 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☒ Claim(s) 11-19 are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 14 April 2011 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. In view of the Appeal Brief filed on 12/20/2011, PROSECUTION IS HEREBY REOPENED. New grounds of Rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

2. This Office Action acknowledges the applicant's amendment filed on 4/14/2011. Claims 1-25 are pending in the application. Claim 26 is cancelled. Claims 11-19 are withdrawn from consideration.

The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3728

4. Claims 1-10 and 20-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification appears to lack a description of how the movement of the applicator member is made due to “hydraulic transmission”. The only related teaching in the specification appears to be on pg. 3 lines 24-25 in the Summary of the Invention. The specification merely states in this section that “Upon application of a force on the activator member, both the activator member and the applicator member move into the capsule body member due to, e.g., hydraulic transmission”. This is not considered to meet the requirements of the Statute in describing how the movement is achieved. It is not clear what is intended by “hydraulic transmission”, as the term is applied to the claimed invention.

5. Claims 1-10 and 20-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Subject matter that was not described in the specification as noted above relates to how hydraulic transmission causes movement of the applicator member or what “hydraulic transmission” is in the context of the claimed invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

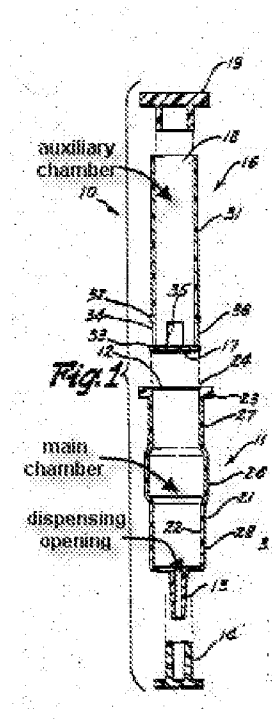
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3728

7. Claims 1-10 and 20-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner does not understand and cannot determine the scope of the limitation that the movement of the applicator member is caused due to "hydraulic transmission". Claim 23 is indefinite since the additional limitation regarding the specific type of dental material as recited in this claim raises a question whether the applicant's intention is to claim the combination of the material with the capsule, as opposed to whether applicant intends to claim the subcombination of the capsule only (based on the dependency of claim 23 on claim 1, and since claim 1 line 1 appears to indicate that the subcombination is claimed). This is a combination/subcombination issue. This office action presumes that applicant's intention is to claim only the subcombination, in order to give the claims their broadest reasonable interpretation.

Claim Rejections - 35 USC § 102

8. Claims 1-4, 8, 10, 20-21 and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Pierick US 3,279,654.



Claim 1/25: Pierick discloses a capsule body member 11 providing a main chamber (see figure above), and comprising a dispensing opening (see figure above), wherein the inner wall 22 of the capsule body member comprises a recessed area 26; an applicator member 16 adapted for slideable accommodation in said capsule body member, said applicator member providing an auxiliary chamber (see figure above), and wherein said applicator member comprises a through-hole 34/35/36 extending from the auxiliary chamber to the outer circumferential surface of the applicator member; and an activator member 19 being slideably accommodated in said applicator member; said through-hole and said recessed area forming a channel between said main chamber and said auxiliary chamber upon activation of said capsule due to movement of said

activator member towards said dispensing opening, causing movement of said applicator member due to hydraulic transmission.

Claim 2: Pierick discloses radially extending through-hole 34/35/36 in said applicator member 16 is initially covered by the wall 22 of said capsule body member 11. (Col 3:20-27)

Claim 3: Pierick discloses said radially extending through-hole 34/35/36 is located in close proximity to the separation wall 17 of said applicator member 16 separating said auxiliary chamber from said mixing chamber.

Claim 4: Pierick discloses said through-hole 34/35/36 extends essentially perpendicularly to the longitudinal axis of said applicator member 16.

Claim 8: Pierick discloses said applicator member 16 comprises a sealing element 32/33 sealing said through-hole 34/35/36 of said applicator member 16 against said recessed area 26 of said body member 11 and against the exterior of said capsule.

Claim 10: Pierick appears to disclose the sealing elements 32/33 are manufactured by a two-component injection moulding process together with the capsule body member 11, the applicator member 16 and said activator member 19.

Alternatively, The product (sealing elements) being manufactured by a two-component injection moulding process encompassed in the claim would have been obvious in view of the apparatus of Pierick, for the purpose providing an

alternate way of forming the sealing elements to the capsule body, applicator member and the activator member.

Claim 20/1: Pierick discloses a dispensing cannula 13/42 connected to said dispensing opening.

Claim 21: Pierick discloses the dispensing cannula 13/42 is integrally formed with said capsule body member 11.

Claim 23/1: Pierick discloses a capsule that is at least inherently capable of use to store, mix and dispense some dental material, such as glass ionomer cement or a resin modified glass ionomer cement.

Claim 24/1: Pierick discloses said main chamber contains a first, preferably powdery, component of said material 29 (Col 2:67-72), and said auxiliary chamber contains a second, preferably liquid, component of said material 37 (Col 3:20-27).

Claim Rejections - 35 USC § 103

9. Claims 5-7, 9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierick US 3,279,654.

Claim 5: Pierick discloses said through-hole that extends essentially at an angle to the longitudinal axis of said applicator member but it does not specifically disclose the angle being smaller than 90°.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the angle be smaller than 90°, since it has been held that where the general conditions of a claim are disclosed in the prior art,

discovering the optimum or workable ranges involves only routine skill in the art.
In re Aller, 105 USPQ 233.

Claim 6 and 7: Pierick discloses a separation wall but it does not specifically disclose the separation wall comprise a raised area extending towards said activator member wherein said raised area comprising an annular bulge.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the separation wall of Pierick to include a raised portion with an annular bulge since it was known in the art that doing so would create an area to allow mixing of the two components.

Claim 9: Pierick discloses an activator member but it does not specifically disclose the activator member comprising an activator sealing element for sealing the activator member against the applicator member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the activation member of Pierick to include a sealing element since it was known in the art that doing so would prevent articles from spilling out of the application member.

Claim 22: Pierick discloses a cannula 42 but it does not specifically disclose the cannula is rotatably connected to the capsule body member thus providing a valve.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the cannula be rotatably connected to the capsule body member since it was known in the art that would allow various types of

cannulas to be used for the capsule such as a needle type or a regular nozzle type.

Response to Arguments

10. Applicant's arguments with respect to claims 1-10 and 20-25 have been considered but are moot because of new grounds of rejection due to amendments to the claims. However, the claims continue to read on Pierick for the reasons noted above.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3728

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENINE PAGAN whose telephone number is (571)270-3216. The examiner can normally be reached on Monday - Thursday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jacob K. Ackun Jr./
Primary Examiner, Art Unit 3728

/Jenine M Pagan/
Examiner, Art Unit 3728